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EXAMINER

DICUS, TAMRA

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,173	<b>Applicant(s)</b> KOBAYASHI ET AL.	
	<b>Examiner</b> TAMRA L. DICUS	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **SUPPLEMENTAL DETAILED ACTION**

The Specification Objection is withdrawn.

The arguments are acknowledged but unconvincing.

### **Claim Objection**

Claim 33 recites "has been formed by", which is not in present tense.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 12-16, 19, 23-26, 28 and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,326,074 to Takahashi.

Takahashi teaches per instant Claim 1. A decorative material comprising at least a substrate (penetrable porous paper 1, FIGS. 1E and 2 and associated text, of penetrable paper, 4:44-45 (claim 16)), a low-luster pattern ink layer (nonpenetrable layer 5, FIGS. 1E and 2 and associated text, of the same compositions comprising pigments, silica (extender), and resins as in [0076] as in instant specification, and printed in a pattern, thus functioning as low-luster pattern ink layer, see also 5:40-68 teaching extender

pigments) partially formed on the substrate, a color solid print (2, FIGS. 1E and 2 and associated text, penetration-preventing) and a surface protective layer (6, FIGS. 1E and 2 and associated text) which is present on and in direct contact with the low-luster pattern ink layer so as to cover a whole surface including both a region where the low-luster pattern ink layer is formed (see regions where 5 is present) and a region where no low-luster pattern ink layer is formed (see regions where 5 is not present), wherein the surface protective layer is formed by crosslinking and curing an ionizing radiation-curable resin composition with UV or electron beam (6:18-30, methacrylate monomer or vinyl acetate or epoxy resins (claims 2, 4, 24), and provided therein with a first low-gloss region which is located in a portion just above the low-luster pattern ink layer (see region above 5, FIGS. 1E and 2 and associated text) and in the vicinity of the portion, and with a second low-gloss region (any area surrounding the pattern layer 5 that isn't one of the aforementioned regions such as to the left or right of the pattern, or any area extending laterally in any direction, or circumferentially surrounding the pattern), inherently having a lower gloss than a second low-gloss region because the same materials are employed, and the low-luster pattern ink layer serves to generate a gloss difference and elution, dispersion, and mixing cause inherently due to the same materials and same structure, wherein the first region is visually recognized as a concave portion (see upper concave sub-regions illustrated in topcoat 6, FIGS. 1E and 2, 4:61-63, Example 1) and the first region has a convex shape (see convex shape in FIGS.

1E and 2). Regarding claims 2- 3 and 1, the nonpenetrable low-luster pattern ink layer contains a non-crosslinked urethane (while not explicitly recited as "non-crosslinked" see 5:50-53, because the urethane is not said to be crosslinked with a crosslinking agent, then it is not crosslinked, and the ionizing resin also includes methacrylate monomer and unsaturated polyester-6:48-50 and 6:39 (while referred to generally at 5:50-51, is explained further to include additional ingredients at 6:39-50, (claims 2-4 and 30-33). Takahashi explains methacrylate monomer may be used alone at 6:35 (claim 4). Color solid print (2, FIGS. 1E and 2, and associated text), Takahashi teaches has an additional function to prevent the penetration of the ink (4:40-46) and states it functions as a penetration prevention layer. (Claims 15 and 26). Takahashi teaches attachment of the sheet to various adherends such as walls (7:50-60) and laminated onto wood or glass plates (4:20-36, claim 28). While Takahashi does not explicitly recite first and second sub-regions/sub-regions and gloss differentials and comparisons, see Examples 1-13 that clearly teach a glossiness (gloss) difference between gloss and non-gloss sub-regions and difference in convex and concave levels (claim 25). Claims 1-4, 12-16, 19, 23-26, 28, and 30-33 are met.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 -4, 23-26, 28, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Tsukada et al.

Takahashi essentially teaches the claimed invention (see materials above for claims 1-2, 23-26, 28 and 30-33).

Takahashi does not expressly refer to a "non-crosslinked" urethane instant claims 1- 3, while the urethane is not said to be crosslinked as set forth above, namely the ink layer containing a non-crosslinked urethane resin and methacrylate for the ionizing radiation-curable resin, or instant claim 3 unsaturated polyester or claim 4.

Tsukada teaches a similar decorative material comprising an ink comprising either an ionizing radiation-curable resin or it's mixture with an ionizing uncureable resin vehicle (binder) employing urethane, polyesters or an acrylic acid modified polyester (similar structure to unsaturated polyester, thus similar properties expected) and a (meth)acrylate monomer (3:10-15, 3:65-68, 4:1-50, 7:60-68, 8:45-68, 9:9-30).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi to use or substitute an uncureable resin and methacrylate monomer because Tsukada teaches they are conventional resins used in inks and similar layers in a decorative material sheet (3:10-15, 3:65-68, 4:1-50, 7:60-68,

8:45-68, 9:9-30). To instant claim 4, choosing solely methacrylate monomer is an obvious choice resin since Tsukada teaches a variety of resins in a list, picking only one is obvious because the same results are expected. Moreover, Takahashi explains said monomer may be used alone at 6:35. Mixtures of said ingredients are obvious to choose from a list of already known materials for known properties producing known results as cited above. See further KSR rationale below.

Claim 5-6 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi.

Takahashi essentially teaches the claimed invention.

Takahashi does not teach instant claims 5-6 and 20-21.

To instant claims 5-6, and 20-21 the sub-layers and thickness are not recited, however, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). The thickness of ink effects the design and aesthetics. Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be

obvious when it does no more than yield predictable results,” KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). The thickness of the low-luster pattern with corresponding sub-layers, because of their thickness, will indeed directly effect the amount of gloss or luster given off.

Further note it is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom...” The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements” in the manner claimed. *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1396. Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Attention is directed to the following regarding the obviousness of ranges of the decorative pattern:

- Printing the low-gloss patterns and sub-layers on a substrate is known in the art as provided by Takahashi et al. set forth above and are purely decorative in nature.
  - It has been held that mere printed matter having no new or unobvious functional relationship between the printed matter and the substrate is unpatentable. See *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983).
  - The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish



the claimed invention from the prior art. See *In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

- Changes in size (i.e. the thickness or size of said pattern layers) are not germane to patentability.
  - Size of an article ordinarily is not a matter of invention. The size and thickness recitations are all deemed matters of choice involving differences in degree and/or size and are not patentable distinctions. In *re Rose*, 105 USPQ 237.
  - In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.
- Manipulating design elements and adjusting the ranges of the decorative patterns including sub-layers are within skill of the art.
  - It has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284.
  - It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Thus, given that the prior art accounts for various patterns, the decorative patterns instantly claimed are obvious and optimizable for providing decoration to the sheet absent unexpected results or criticality.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi solely or further in view of Tsukada et al.

Takahashi or the combination is relied upon above.

Takahashi or the combination does not teach the thickness recited, however, it is submitted the optimal and/or claimed values of the respective material would have

been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). Thickness effects the optical effect.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi solely or further in view of Tsukada et al. and further in view of Ogawa.

The references are relied upon above.

Said references do not teach the particles as per instant claim 21.

Ogawa teaches fine particles, particularly, baked kaolin which is a widely known filler and used as an equivalent to calcium carbonate and mixed with silica applied to a variety of films and coating resin compositions (9:30-68,10:1-55).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi or the combination to include the ingredients as claimed because Ogawa teaches baked kaolin is a widely known filler used as equivalents to calcium carbonate and mixed with silica (10:1-15) applied to a variety of films (9:30-68). Further, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum

value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi solely or further in view of Tsukada et al. and further in view of 4,855,184 to Klun et al.

The references are relied upon above.

Said references do not teach the particles as per instant claim 22.

Klun teaches a radiation-curable coating protective layer of ethylene oxide and propylene oxide with N-methylolacrylamides for wood or plastic coatings; see further 1:1-10, 18: 25-30, 20:19-30.

Ogawa teaches fine particles, particularly, baked kaolin which is a widely known filler and used as an equivalent to calcium carbonate and mixed with silica applied to a variety of films and coating resin compositions (9:30-68,10:1-55).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi or the combination to include the ingredients as claimed because Klun teaches it is a composition for radiation -curable protective coatings for plastic and wood substrates and Ogawa teaches baked kaolin is a widely known filler used as equivalents to calcium carbonate and mixed with silica (10:1-15) applied to a variety of films (9:30-68).

Claim 7-10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of US 6,841,221 to MacQueen.

Takahashi essentially teaches the claimed invention above.

Takahashi discloses the ionizing radiation curable resin composition for the surface protecting layer.

Takahashi does not expressly teach the composition recited per instant claims 7-10, but does teach a similar curable coating. Takahashi teaches pigments and fine powders of calcium carbonate, and silica may be further additives within the ionizing radiation curing resin (7:10-20), which the surface layer is comprised of.

MacQueen teaches a decorative material wherein fine micro-capsules having a particle size of between 5-80 microns in a preferable concentration of 0.1-10 wt.% (falling within Applicant's range-claim 10) wherein said wt% may be varied to produce a textured protruding surface is overcoated with a similar UV curable urethane resin composition resulting in an aesthetically pleasing surface including properties such as wear and slip resistance. See Abstract, 1:1-35, 4:25-68, 5:1-10, 6:1-20, 7:19-50, FIG. 1(c).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi to include the protruding fine particles as claimed because MacQueen teaches results such as an aesthetically pleasing surface including properties such as wear and slip resistance as cited above.

Takahashi does not expressly teach all the values recited per instant claims 7-10. It is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since MacQueen explains concentration and size effects the texture and aesthetics, and since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). Further thickness is a size modification and effects the texture. Moreover, it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284. Size of an article ordinarily is not a matter of invention. The size and thickness recitations are all deemed matters of choice involving differences in degree and/or size and are not patentable distinctions. *In re Rose*, 105 USPQ 237.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi solely or in view of US 4,855,184 to Klun et al. and in view of USPN 5,266,397 to Ogawa et al.

Takahashi essentially teaches the claimed invention above.

Takahashi discloses the ionizing radiation curable resin composition for the surface protecting layer.

Takahashi does not expressly teach the composition recited per instant claim 11, but does teach trimethylolpropane ethylene oxide tri(meth)acrylate see 6:56-57.

Takahashi teaches pigments and fine powders of calcium carbonate, and silica may be further additives within the ionizing radiation curing resin (7:10-20), which the surface layer is comprised of. However, Takahashi does not teach baked kaolin per instant claim 11.

Klun teaches a radiation-curable coating protective layer of ethylene oxide and propylene oxide with N-methylolacrylamides for wood or plastic coatings; see further 1:1-10, 18: 25-30, 20:19-30.

Ogawa teaches fine particles, particularly, baked kaolin which is a widely known filler and used as an equivalent to calcium carbonate and mixed with silica applied to a variety of films and coating resin compositions (9:30-68,10:1-55).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi to include the ingredients as claimed because Klun teaches it is a composition for radiation -curable protective coatings for plastic and wood substrates and Ogawa teaches baked kaolin is a widely known filler used as equivalents to calcium carbonate and mixed with silica (10:1-15) applied to a variety of films (9:30-68).

Claims 1, 5-6, 17-18 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,558,799 to Takeuchi et al. in view of Takahashi.

Takeuchi teaches a decorative material in this order : 1, substrate (the Figure and associated text), 2A a penetrating preventing or color layer, 2B contains a pattern print, 2C is a color/penetration preventing layer, having a surface layer 3 on top. All of the layers except the substrate is from the same ionizing curable resin.

Takeuchi does not teach a concave portion and ink layer in that order laminated over the order per the instant claims.

Takahashi teaches a decorative material comprising at least a substrate (penetrable porous paper 1, FIGS. 1E and 2 and associated text, of penetrable paper, 4:44-45), a low-luster pattern ink layer (nonpenetrable layer 5, FIGS. 1E and 2 and associated text, of the same compositions comprising pigments, silica (extender), and resins as in [0076] as in instant specification, and printed in a pattern, thus functioning as low-luster pattern ink layer, see also 5:40-68 teaching extender pigments) partially formed on the substrate, and a surface protective layer (6, FIGS. 1E and 2 and associated text) which is present on and in direct contact with the low-luster pattern ink layer so as to cover a whole surface including both a region where the low-luster pattern ink layer is formed (see regions where 5 is present) and a region where no low-luster pattern ink layer is formed (see regions where 5 is not present), wherein the surface protective layer is formed by crosslinking and curing an ionizing radiation-curable resin composition

(methacrylate monomer or vinyl acetate or epoxy resins), and provided therein with a first region which is located in a portion just above the low-luster pattern ink layer (see region above 5, FIGS. 1E and 2 and associated text) and in the vicinity of the portion, and with a second region (any area extending laterally, or circumferentially surrounding the pattern layer 5 that isn't one of the aforementioned regions such as to the left or right of the pattern), inherently having a lower gloss than a second region because the same materials are employed, and the low-luster pattern ink layer serves to generate a gloss difference inherently due to the same materials, wherein the first region is visually recognized as a concave portion (see upper concave sub-regions illustrated in topcoat 6, FIGS. 1E and 2, 4:61-63, Example 1) and the first region has a convex shape (see convex shape in FIGS. 1E and 2). While Takahashi does not explicitly recite first and second sub-regions/sub-regions and gloss differentials and comparisons, see Examples 1-13 that clearly teach a glossiness (gloss) difference between gloss and non-gloss sub-regions and difference in convex and concave levels.

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takeuchi to include overtop a laminated topcoat surface protective layer and low-gloss pattern as claimed because Takahashi teaches such a covering provides an embossed three-dimensional effect (4:1-15 and as cited above).



The woodgrain pattern (9:50-60 inherently having vessels because it is a wood grained pattern) of claim 18 is provided by Takeuchi and embraced (4:45-60, grains, tile patterns) by Takahashi, and would have been expected to produce a pattern as set forth in claim 18.

To instant claims 5-6, the thickness is not recited, however, the same silk screen printing method is used as in the instant specification (9:35-40, Takeuchi), and materials, and thus the thickness would be expected. It is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). The thickness of the low-luster pattern with corresponding sub-layers, because of their thickness, will indeed directly effect the amount of gloss or luster given off.

Further note it is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be

expected to draw therefrom..." The analysis supporting obviousness, however, should be made explicit and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" in the manner claimed.

*KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1396. Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Attention is directed to the following regarding the obviousness of ranges of the decorative pattern:

- Printing the low-gloss patterns and sub-layers on a substrate is known in the art as provided by Takahashi et al. set forth above and are purely decorative in nature.
  - It has been held that mere printed matter having no new or unobvious functional relationship between the printed matter and the substrate is unpatentable. See *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983).
  - The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See *In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947).
- Changes in size (i.e. the thickness or size of said pattern layers) are not germane to patentability.
  - Size of an article ordinarily is not a matter of invention. The size and thickness recitations are all deemed matters of choice involving differences in degree and/or size and are not patentable distinctions. *In re Rose*, 105 USPQ 237.
  - In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently

than the prior art device, the claimed device was not patentably distinct from the prior art device.

- Manipulating design elements and adjusting the ranges of the decorative patterns including sub-layers are within skill of the art.
  - It has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284.
  - It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Thus, given that the prior art accounts for various patterns, the decorative patterns instantly claimed are obvious and optimizable for providing decoration to the sheet absent unexpected results or criticality. Mixtures of said ingredients are obvious to choose from a list of already known materials for known properties producing known results as cited above. See further KSR rationale above.

Claims 2-4 , 27-29 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,558,799 to Takeuchi et al. in view of Takahashi and further in view of Tsukada et al.

Takeuchi teaches a decorative material in this order : 1, substrate (the Figure and associated text), 2A a penetrating preventing or color layer, 2B contains a pattern print, 2C is a color/penetration preventing layer, having a surface layer 3 on top. All of the layers except the substrate are from the same ionizing curable resin.

Takeuchi does not teach a concave portion and ink in that order laminated over the order as disclosed by Takeuchi and the instant claims. Takeuchi doesn't explicitly reference a "non-crosslinked" urethane as per instant claim 2, namely the ink layer containing a non-crosslinked urethane resin and methacrylate for the ionizing radiation-curable resin or the ingredients per claims 3-4 and 32-33.

Takahashi teaches a decorative material comprising at least a substrate (penetrable porous paper 1, FIGS. 1E and 2 and associated text, of penetrable paper, 4:44-45), a low-luster pattern ink layer (nonpenetrable layer 5, FIGS. 1E and 2 and associated text, of the same compositions comprising pigments, silica (extender), and resins as in [0076] as in instant specification, and printed in a pattern, thus functioning as low-luster pattern ink layer, see also 5:40-68 teaching extender pigments) partially formed on the substrate, and a surface protective layer (6, FIGS. 1E and 2 and associated text) which is present on and in direct contact with the low-luster pattern ink layer so as to cover a whole surface including both a region where the low-luster pattern ink layer is formed (see regions where 5 is present) and a region where no low-luster pattern ink layer is formed (see regions where 5 is not present), wherein the surface protective layer is formed by crosslinking and curing an ionizing radiation-curable resin composition (methacrylate monomer or vinyl acetate or epoxy resins), and provided therein with a first region which is located in a portion just above the low-luster low-luster pattern ink layer (see region above 5, FIGS. 1E and 2 and associated text) and in the vicinity of the

portion, and with a second region (any area surrounding the pattern layer 5 that isn't one of the aforementioned sub-regions such as to the left or right of the pattern), inherently having a lower gloss than a second region because the same materials are employed, and the low-luster pattern ink layer serves to generate a gloss difference inherently due to the same materials, wherein the first region is visually recognized as a concave portion (see upper concave sub-regions illustrated in topcoat 6, FIGS. 1E and 2, 4:61-63, Example 1) and the first region has a convex shape (see convex shape in FIGS. 1E and 2). Takahashi teaches attachment of the sheet to various adherends such as walls (7:50-60) and laminated onto wood or glass plates (4:20-36, claim 28). While Takahashi does not explicitly recite first and second sub-regions/sub-regions and gloss differentials and comparisons, see Examples 1-13 that clearly teach a glossiness (gloss) difference between gloss and non-gloss sub-regions and difference in convex and concave levels.

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takeuchi to include overtop a laminated topcoat surface protective layer and low-gloss pattern as claimed because Takahashi teaches such a covering provides an embossed three-dimensional effect (4:1-15 and as cited above).

The combination does explicitly reference a "non-crosslinked" urethane as per instant claim 2, namely the ink layer containing a non-crosslinked urethane resin and

methacrylate for the ionizing radiation-curable resin or the ingredients per claims 3-4 and 32-33.

Tsukada teaches a similar decorative material comprising an ink comprising either an ionizing radiation-curable resin or it's mixture with an ionizing uncureable resin vehicle (binder) employing urethane, polyesters or an acrylic acid modified polyester (similar structure to unsaturated polyester, thus similar properties expected) and a (meth)acrylate monomer (3:10-15, 3:65-68, 4:1-50, 7:60-68, 8:45-68, 9:9-30).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of the combination to use an uncureable resin and methacrylate monomer because Tsukada teaches they are conventional resins used in inks and similar layers in a decorative material sheet (3:10-15, 3:65-68, 4:1-50, 7:60-68, 8:45-68, 9:9-30). Mixtures of said ingredients are obvious to choose from a list of already known materials for known properties producing known results as cited above. See further KSR rationale above.

### *Response to Arguments*

Applicant's arguments filed 02/12/09 have been fully considered but they are not persuasive.

Applicant appears to argue references individually, when there is only one reference used over the rejection under 102b.

Applicant argues "it must be emphasized that in Takahashi, the layer 5 is a layer not penetrable by the top coat 6". The Examiner does not disagree with the teaching of layer 5, FIGs. 1E-2 as taught by Takahashi.

Applicant argues a mixture of resin component of the low-luster pattern ink and the reaction is not taught. This argument is not persuasive because the interaction must be present because the exact same materials in the exact same order are taught or obvious as expressed in detail above. Anything that occurs in the regions surrounding the structural layers is inherently provided, despite Applicant's arguments to the contrary or to allegations to teaching away.

Applicant argues Takeuchi to structural elements, however, this reference was used to point to the materials in the combination with Takahashi.

Applicant argues claims 15 and 26 to where the penetration-preventing layer is, which the Examiner understands. Applicant argues in contrast, Takahashi's layer 5 must be between 4 and 6, but is off line. Because the only way for this to occur is for the 5 to extend completely across to cover and be in contact with 4, which Applicant doesn't even claim since it needs to be not present in areas where 4 is. FIG. 1E, layer 5 is equivalent to the lower-luster pattern ink layer and the prevention layer is 2, the color solid print layer, which is placed as the claims require. Applicant argues pages 1-6 of specification, but the claims don't limit to what is argued.

Applicant argues the gloss difference and mixing cause as claimed pointing to a method, suspending portions and a suspended state in the instant specification, however, Applicant has not made a convincing argument because limitations from the specification are not read into the claims, the final product is of issue and not the process of making it, and because the exact same material and exact same structure (including in direct contact of the low-luster pattern and surface protective layers and thus interaction indeed occurs, despite Applicant's arguments to the contrary) is employed, the exact same results and properties are inherently expected. See in detail the 102(b) rejection over Takahashi above. When the claimed and prior art products are identical or substantially identical in structure or are produced by identical or a substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 ( Fed. Cir. 1990). The *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See



MPEP § 2112- 2112.02. Thus all arguments to the properties not being taught including the mixing cause as claimed over Takahashi and Tsukada, the above explanation and rationale is applied.

Applicant argues none of the claims as recited are taught by the references set forth, however, this is not convincing because the primary references teach the claimed invention. See again Takahashi explicitly teaching all of the layers and their gloss and convex appearances. Further because the exact same material is used, it is expected that the effects are inherently present or obviously expected despite Applicant's allegation that the references do not teach this. Applicant further argues properties such as excellent durability, satisfactory feel, and less complicated processing and costs, and light scattering; however, these are properties and effects that naturally flow from the same materials and ordered structures.

The Applicant argues the direct contact between the surface protective layer and low-luster pattern ink layer, again, as set forth above, Takahashi's surface protective layer 6 is in direct contact with low-luster pattern ink layer 5 see FIG 1E. The composition of layer 5 includes a binder, solvent, and pigment, which is the formula for ink and Takashshi also teaches this layer is printed, while not expressly referring to it as "ink".

Applicant also points to Fig. 1 of the instant specification, further arguing curing in a suspended state, however, this is not in the claim and is further a process limitation, but is nonetheless provided in the prior art because the final product is cured.

Further discussion to Takahashi has been discussed above, namely the nonpenetrable layer is a low-luster pattern ink layer as the same composition and printing is provided for by Takahashi, in response to Applicant's arguments to the separation of the pattern layer from the top coat layer.

Applicant argues Tsukada doesn't teach the direct contact limitations, however, as set forth above, Takahashi teaches this limitation. Takeuchi was relied upon to teach the successive lamination, further adding the layers of Takahashi are obvious to coat over it to add a 3-D effect. Applicant further argues Takeuchi's layer 2C is not the patterned layer; however, the Examiner does not rely on 2C as the patterned layer, but the color penetration prevention layer as set forth above. All other references are used for the reasons set forth above.

Applicant points to pages 10-24 and page 24, lines 8-19, but none of the points argued is claimed.

Applicant argues teaching away in Takahshi because the properties of interacting as claimed are quite different form the ink of Takahashi. The Examiner doesn't see how this occurs since the exact same materials are used, it is not exactly clear how there is a difference. Again, note: When the claimed and prior art products are identical or

substantially identical in structure or are produced by identical or a substantially identical processes, a prima facie case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 ( Fed. Cir. 1990).

Applicant argues compatibility and different mechanisms, however, mechanisms are not claimed, and compatibility is expected for reasons expressed in detail above to the same materials and structure.

Applicant's arguments to what would or would not happen, is not convincing as Applicant argues speculation and has not provided objective evidence to prove his allegations (e.g. interaction with layers to cause all affects/properties claimed, top coat 6 would not be non-crosslinked-urethane).

Applicant points to layer 4 of Takahashi, but this is not referenced in the 102b rejection. Applicant argues " Again emphasizing that layer 5 in Takahashi is expressly disclosed as a nonpenetrable layer, it is respectfully submitted that this reference does not disclose, nor would have suggested, a low-gloss region as in the present claims, and advantages thereof." Applicant appears to be confusing region and layer, the region surrounds the layer just as claimed.

All supportive & supplemental references are used for reasons as indicated above. The structure is again taught by Takahashi within the meaning of 102b.

Applicant argues the direct contact of substrate and low-luster pattern ink layer, however, the entire phrase of this limitation also states "where no low-luster pattern ink layer is formed", and thus is discontinuous and not in the form as Applicant argues on page 29, 3rd complete paragraph.

Applicant argues properties of ink, again, because the ink is the same it is inherent anything that follows naturally therefrom as referenced above.

*A prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699,705, 222 USPQ 191, 196 (Fed. Cir. 1984). Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney, can be reached on 571-272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/  
Examiner  
Art Unit 1794

May 14, 2009

/Bruce H Hess/  
Primary Examiner, Art Unit 1794